

## REMARKS

The prior art statement accompanying this application for reissue cites and provides copies of all of the patents cited in successor divisional and continuation-in-part patent 6,630,229.

The amendment to independent claims 1 and 21 introduces to each the limitation that the furnish contains fiber, as recited by dependent claims 11-14. The amendment to claims 1 and 21 also adds to each the limitation that the coated paper has a coating weight/fiber weight ratio on the order of 6% -31%, which is in conformity with the ratio set forth in independent claim 1 of successor patent No. 6,630,229 (discussed below) and finds support in the relatively broader recitation of claim 27. The amendment to independent claims 23 and 32 introduces to each the limitations found in their respective dependent claims 27 and 36, i.e., that the furnish contains fiber and the coated paper has a coating weight/fiber weight ratio on the order of 5% -31%. The amendment to dependent claims 11-14 cancels from each the recitation that the furnish contains fiber, since that limitation has been introduced to independent claim 1, from which claims 11-14 depend.

The amendments to the claims do not introduce new matter.

The circumstances leading to the filing of this application for reissue of patent 5,952,082 began with a restriction requirement between process and product claims in the application that issued as the patent. The process claims were elected for prosecution and the patent issued with claims directed to the steps involved in the process of making the patentees' coated paper. To preserve the invention of the non-elected product claims, a divisional application was filed June 18, 1999 as serial No.

09/335,593, and was later abandoned in favor of a further divisional and continuation-in-part application filed June 9, 2000 as serial No. 09/591,040. The latter application issued as patent No. 6,630,229 on October 7, 2003, with product claims directed to the patentees' coated paper.

In the prosecution of successor patent 6,630,229, the patents to Windhager 4,306,996, Ma et al. 5,635,279 and Shaw et al. 4,341,839, and toward the end of the prosecution the patent to Schiller 4,308,320, were cited and applied in various rejections of the product claims. In responding to the rejections, the independent claims were amended to include the limitations that the coated paper contains fiber and has coating weight/fiber weight ratios that fall within certain specified ranges, which limitations were found in some of the dependent claims. It was argued that none of the references, some of which did not even mention the presence of fiber in coated paper, taught any fiber weights whatever for paper, and therefore did not and could not teach the particular coating weight/fiber weight ratios called for by the amended claims. The argument was not initially persuasive, apparently because the examiner was of the mistaken impression that the fiber weight of coated paper is the same as its basis weight, such that the examiner apparently thought that the basis weights of the coated papers taught by the references were the same as and therefore a teaching of fiber weights of the coated papers, leading the examiner to the erroneous conclusion that the references taught the claimed coating weight/fiber weight ratios. However, following further argument and explanation by the patentees as to why the basis weight and fiber weight of a coated paper are not and cannot be the same, the product claims were allowed and patent 6,630,229 issued.

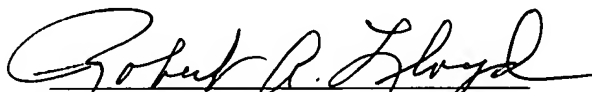
Although the patents to Windhager 4,306,996, Ma et al. 5,635,279, Shaw et al. 4,341,839 and Schiller 4,308,320 were cited and considered by the Patent Office in the prosecution of successor divisional and continuation-in-part patent 6,630,229, they were not considered by the Patent Office in the prosecution of prior parent patent 5,952,082. Consequently, in view of the similarities between the process claims of parent patent 5,952,082 and the product claims of later patent 6,630,229 prior to the amendment that preceded their allowance, the patentees believe that through error and without any deceptive intent they have claimed more than they had the right to claim in patent 5,952,082. This preliminary amendment therefore adds to the independent process claims of patent 5,952,082, limitations that are along the lines of those that were added to and preceded the allowance of the product claims of successor patent 6,630,229, i.e., that the paper contains fiber and that the coated paper has certain coating weight/fiber weight ratios.

The failure to bring Windhager 4,306,996, Ma et al. 5,635,279, Shaw et al. 4,341,839 and Schiller 4,308,320 to the attention of the Patent and Trademark Office in the prosecution of patent 5,952,082 occurred without any deceptive intent. Windhager 4,306,996, Shaw et al. 4,341,839 and Ma et al. 5,635,279 were not known to the patentees or their attorneys at the time of prosecution of parent patent 5,635,279, and did not become known until they were later cited in the prosecution of successor patent 6,630,229. Schiller 4,308,320, which is not considered to be material to the claims of patent 5,635,279, also was not known to the patentees (except for the patentee Gary G. Schiller) or their attorneys at the time of prosecution of patent 5,635,279, and did not become known until it was later cited in the prosecution of successor patent 6,630,229.

Schiller patent 4,308,320 was, however, known to inventor Gary D. Schiller at the time of filing patent 5,635,279 (and at the time of filing patent 6,630,229), because it issued to Mr. Schiller on December 29, 1981 from an application filed August 20, 1980. However, as stated by Mr. Schiller in his accompanying Declaration, he considers the inventions of patents 4,308,320 and 5,635,279 to be so different that the teachings of patent 4,308,320 are not material to the patentability of the invention of patent 5,635,279, and for that reason he did not bring patent 4,308,320 to the attention of the Patent and Trademark Office in connection with patent 5,635,279.

It is submitted that the patents to Windhager 4,306,996, Ma et al. 5,635,279, Shaw et al. 4,341,839 and Schiller 4,308,320, whether taken alone or in combination, do not teach or suggest the invention defined by the process claims of patent 5,952,082 as amended by this application for reissue, just as they do not teach or suggest the invention of the product claims of successor patent 6,630,229, as earlier determined by the Patent and Trademark Office. Accordingly, and as the circumstances leading to this application for reissue occurred through error and without any deceptive intent, it is respectfully requested that this application for reissue be found to be proper and in good order, that the amendment to the claims be approved and that patent 5,952,082 be reissued as amended.

Respectfully submitted,

  
Robert A. Lloyd, Reg. No. 25,694

Pyle & Piontek  
221 N. LaSalle Street, Suite 850  
Chicago, IL 60601  
(312) 236-8123

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. Reissue Application of	)	
Stora Enso North America	)	
	)	Examiner:
Serial No.:	)	
	)	Art Unit:
Filed:	)	
	)	Atty. Docket: CPI 40076D
For: Electrophotographic Recording	)	
Medium and Method	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT UNDER 37 CFR 1.173(c)**  
**STATUS AND SUPPORT FOR**  
**CHANGES TO THE CLAIMS**

Claim 1. Amended. The added limitation that the furnish contains fiber is found in dependent claims 11-14. The added limitation that the coated paper has a coating weight/fiber weight ratio on the order of 6% -31% finds support in the relatively broader recitation of claim 27 as conformed to the particular ratio that set forth in independent product claim 1 of successor divisional and continuation-in-part patent No. 6,630,229.

Claims 2-10. Pending.

Claims 11-14. Amended. The limitation that the furnish contains fiber has been deleted since it has been added to independent claim 1, from which claims 11-14 depend.

Claims 15-20. Pending.

Claim 21. Amended. The added limitation that the furnish contains fiber is found in dependent claims 11-14. The added limitation that the coated paper has a coating weight/fiber weight ratio on the order of 6% -31% finds support in the relatively broader recitation of claim 27 as conformed to the particular ratio that set forth in independent product claim 1 of successor divisional and continuation-in-part patent No. 6,630,229.

Claim 22. Pending.

Claim 23. Amended. The added limitations that the furnish contains fiber and the coated paper has a coating weight/fiber weight ratio on the order of 5% -31% are found in now cancelled dependent claim 27.

Claims 24-26. Pending.

Claim 27. Cancelled.

Claims 28-31. Pending.

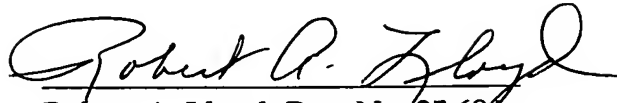
Claim 32. Amended. The added limitations that the furnish contains fiber and the coated paper has a coating weight/fiber weight ratio on the order of 5% -31% is found in now cancelled dependent claim 36.

Claims 33-35. Pending.

Claim 36. Cancelled.

Claims 37-41. Pending.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Lloyd". The signature is fluid and cursive, with a large initial "R" and "L".

Robert A. Lloyd, Reg. No. 25,694

Pyle & Piontek  
221 N. LaSalle Street, Suite 850  
Chicago, IL 60601  
(312) 236-8123